



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,373	09/01/2000	Sean C Semple	INEX.P-007	5857

21121 7590 05/09/2003
OPPEDAHL AND LARSON LLP
P O BOX 5068
DILLON, CO 80435-5068

EXAMINER

NAFF, DAVID M

ART UNIT	PAPER NUMBER
----------	--------------

1651

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER E9/654373	FILING DATE 9/1/00	FIRST NAMED APPLICANT Sample	ATTORNEY DOCKET NO. INEX. P-007
EXAMINER K. Hoff			
ART UNIT 1651		PAPER NUMBER 14	

DATE MAILED:

This is a communication from the Examiner in charge of this application.
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.
Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b))

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purpose of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☒ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.
- NOTE: Change in disclosure of specification by amendment and added limitation to claim 1 by amendment raise new issues for consideration and raise new matter issue
3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112 rejection
4. ☐ Newly proposed or amended claim(s) _____ would be allowed if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purpose of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None

Claim(s) objected to: None

Claim(s) rejected: 1-9

Claim(s) withdrawn from consideration: 10-22

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved, or b) ☐ disapproved by the Examiner.
- the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

[Signature]
EXAMINER
1651

Claims in the application are 1-22.

Restriction to one of the following inventions is required under
35 U.S.C. 121:

- I. Claims 1-9, drawn to a composition comprising a population of
oligodeoxynucleotide-containing lipid vesicles, classified in
class 424, subclass 450.
- II. Claims 10-22, drawn to a method for preparing
oligodeoxynucleotide encapsulated in the lumen of interlamellar
spaces of small multilamellar lipid vesicles, classified in
class 536, subclass 22.1.

The inventions are distinct, each from the other because:

Inventions I and II are related as process of making and product
made. The inventions are distinct if either or both of the following can
be shown: (1) that the process as claimed can be used to make other and
materially different product or (2) that the product as claimed can be
made by another and materially different process (MPEP § 806.05(f)). In
the instant case, the product of I can be made by a different process
such as by the process disclosed in WO 96/40964 (page 3, line 5 of the
specification) or by the process disclosed in U.S. Patent 6,287,591 that
issued from parent application 09/078,954. Additionally, the product of
I could be obtained without using a filter as in step (d) of claim 10 of
II such as by using agitation or homogenization to obtain small vesicles.

Because these inventions are distinct for the reasons given above
and have acquired a separate status in the art as shown by their
different classification, restriction for examination purposes as
indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-
5 elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10 Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M. Naff whose telephone number is (703) 308-0520. The examiner can normally be reached on Monday-Thursday and every other Friday from about 8:30 AM to about 6:00 PM.


15 If attempts to reach the examiner by telephone are unsuccessful, a message can be left on voice mail.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn, can be reached at telephone number (703) 308-4743.

20 The fax phone number is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

25 DMN
12/7/01


DAVID M. NAFF
PRIMARY EXAMINER
ART UNIT 1651